

193414US-2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
Tatsuya KUNIKIYO : GROUP ART UNIT: 2814  
SERIAL NO: 09/612,298 :  
FILED: July 7, 2000 : EXAMINER: P. CAO  
FOR: SEMICONDUCTOR DEVICE

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RESPONSE TO ELECTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the election requirement of September 10, 2001, Applicants elect, with traverse, Species I. Claims 1 and 7-15 read on this species.

The proper criteria for restriction between distinct inventions is provided in MPEP §803. The two criterion are (1) the inventions must be independent or distinct as claimed and (2) there must be a *serious* burden on the examiner if restriction is not required. Regarding the second criterion, if the search and examination of an entire application can be made without a serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions (MPEP §803 (emphasis ours)).

The Office Action has not addressed the issue of whether there is a serious burden. The election cannot be maintained unless there is a serious burden. It has not been alleged that searching is a burden, and the two species appear to have the same search criterion. Moreover, using electronic searching, a search may be made of a large number of, or possibly all, classes and subclasses without any additional effort. Examining only two species and a total of 20 claims also presents no serious burden.

There is thus little, if any, extra effort in searching and examining claims 1-20 compared to searching and examining claims 1 and 7-15, even though the inventions of species I and II are distinct. It is therefore respectfully submitted that there is no serious burden on the examiner, and examination of claims 1-20 in this application is proper.

It is respectfully submitted that examination on the merits is in order, and an early and favorable decision is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No. 25,599  
Carl E. Schlier  
Registration No. 34,426



**22850**

(703) 413-3000  
(703) 413-2220 (fax)  
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